

Application No.: 09/961025

Case No.: 56022US012

Remarks

Favorable reconsideration of this application in the light of the amendments and the following discussion is respectfully requested. Claim 5 has been amended. Claims 1-17 remain pending in this application for consideration. Claims 18-29 have been withdrawn.

Restriction Requirement under 35 U.S.C. § 121:

Restriction to one of the following inventions was required under 35 U.S.C. § 121:

- I. Claims 1-17 and 30 are said to be drawn to a process of making microporous film, classified in Class 264, subclass 41;
- II. Claims 18-29 are said to be drawn to an apparatus for making microporous film, classified in Class 425, subclass 224.

The Examiner averred that inventions are distinct, each from the other because the apparatus as claimed can be used to practice another and materially different process such as a process of making a film, sheet or web which is not porous or microporous.

The Examiner stated that the restriction is proper because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification.

During a telephone conversation with the undersigned Attorney on 22 September 2003, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-17 and 30. The Examiner indicated that affirmation of this election must be made by applicant in replying to this Office Action. Claims 18-29 were withdrawn from further consideration by the Examiner.

Applicants' Response to the Restriction Requirement under 35 U.S.C. § 121

Applicants affirm the election, with traverse, to prosecute the invention of group I, claims 1-17, and 30 comprising a process of making microporous films.

Applicants respectfully traverse the restriction requirement. M.P.E.P. § 803 requires that the two conditions be met for a proper requirement for restriction between patentably distinct inventions. First, the inventions must be independent or distinct as claimed. Second, there must

Application No.: 09/961025

Case No.: 56022US012

also be serious burden on the Examiner if restriction is not required (see M.P.E.P. §803.02; §806.04 (a)-(j); §808.01 (a); and §808.02).

Applicants submit the restriction between groups I and II is improper because the claims would not impose a serious burden on the Examiner if both groups were prosecuted under the same application. In support, applicants respectfully point out that both groups I and II represent the manufacture of microporous films. Reconsideration is respectfully requested.

Objections

The disclosure was objected to by the Examiner because a serial number was missing on page 8. The Examiner also averred that the title of the invention is not descriptive.

Applicants' Response to the Objections

Applicants have amended the specification as requested by the Examiner. Additionally, applicants have made minor grammatical and stylistic changes to the specification in order to clarify the present invention. With respect to the amendment on page 8, line 20, Applicants aver that the inclusion of the qualifier "generally" to the ingredients of the microporous film is fully supported by the non-limiting examples of additives found on page 9, lines 1-5 and through recitation of the ingredients in dependent claim 6. Applicants have also amended claim 5 of the present application. The amendment clarifies the invention without adding any further limitation to the claim. No new matter is added to the application through the amendments to the specification or the amendment to claim 5.

Rejection Under 35 U.S.C. § 102

Claim 30 was rejected under 35 USC § 102(b) as being anticipated by Latham et al (GB 1,409,786). According to the Examiner, Latham et al teaches a process of preventing contamination of a pinning wire as set forth in the instant claim. The Examiner indicated that Claims 1-17 are allowable over the prior art references presently of record.

Applicants' Response to the Rejection Under 35 U.S.C. § 102

Applicants have canceled claim 30 from the application and seek allowance of claims 1-17.

Application No.: 09/961025Case No.: 56022US012

In view of the foregoing remarks, favorable reconsideration of the present application and the passing of this case to issue with all pending claims allowed is courteously solicited. Should the Examiner wish to discuss any aspect of this application, applicants' attorney suggests a telephone interview in order to expedite the prosecution of the application.

Respectfully submitted,

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Date

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